

REMARKS

This is in response to the Office Action mailed October 27, 2005. In the Office Action, claims 17-30 were indicated as pending and rejected. As an initial matter, Applicant respectfully notes that claims 1-16 are also pending as noted on page five of Applicant's Preliminary Amendment filed with this re-issue application.

Sections One and Two of the Office Action indicated that the re-issue Oath/Declaration filed with this application was allegedly defective because it does not mention the Preliminary Amendment. Further, the Office Action asserted that a Supplemental Oath is needed in this case. Applicant has reviewed the authority cited by the Office Action to support this requirement (37 C.F.R. §1.175 as well as Section 1414 of The Manual Patent Examining Procedure) and respectfully notes that neither provision specifically requires reference to any Preliminary Amendment filed with the re-issue application. According, Applicant respectfully requests reconsideration of this requirement. However, should this requirement be maintained, Applicant will comply with provision of the requested Supplemental Oath.

Section Three of the Office Action indicated that claims 17, 18, 25 and 26 were rejected under 35 U.S.C. §251 as allegedly being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present re-issue is based.

Applicant respectfully notes that the three-step test for recapture is laid out in Section 1412.02 of The Manual Patent Examining Procedure. Specifically, the three-step test is as follows:

The first step is to determine whether and in what aspect the re-issue claims are broader than the patent claims;

The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter; and

Finally, there must be a determination whether the re-issue claims were materially narrowed in other respects to avoid the recapture rule.

Applicant respectfully notes with respect to the third prong, that MPEP §1412.02(I)(C) provides, "However, if the re-issue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the re-issue claim may not be rejected under the recapture doctrine." Applicant respectfully invokes this language with respect to amended claim 17 that now recites, in significantly broader form, the limitation originally introduced in the parent application. Accordingly, Applicant respectfully submits that amended independent claim 17 is no longer subject to the recapture doctrine. Further, Applicant respectfully submits that dependent claims 18 and 25 are similarly not subject to the recapture doctrine by virtue of their dependency from amended independent claim 17.

With respect to independent claim 26, Applicant respectfully notes that the Office Action asserts on page 12 that independent claim 26 corresponds to original claim 12 in the original application. Applicant respectfully submits that independent claim 26 is also narrower than original independent claim 12 of the application upon which the present re-issue is based. Moreover, the features of original dependent claim 13, introduced into original independent claim 12, provide a different solution and manner of distinguishing over the art of record in the application upon which the present re-issue is based. Specifically, independent claim 26 provides,

generating an indication of the polarity of the sample clock;

generating the controller output as a further function of the evaluation and the polarity indication; and correcting the level output as a function of the evaluation output.

Thus, Applicant respectfully submits that independent claim 26 is not subject to recapture doctrine and respectfully requests that the rejection under 35 U.S.C. §251 be withdrawn.

In conclusion, Applicant respectfully submits that the entire re-issue application is now in condition for allowance. Reconsideration and favorable action are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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